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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,568	06/25/2003	Daniel S. Choi	WEB-922-CIP-US	3360
7590 10/20/2005			EXAMINER	
Baker & McKenzie LLP 130 E. Randolph Drive Chicago, IL 60601			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

80

Office Action Summary	Application No. 10/603,568	Applicant(s) DANIEL S. CHOI	
	Examiner Jacob Y. Choi	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
 4a) Of the above claim(s) 31-44 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-30 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 6/25/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 6/30/2005 disclaiming the terminal portion of any patent granted on this application has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

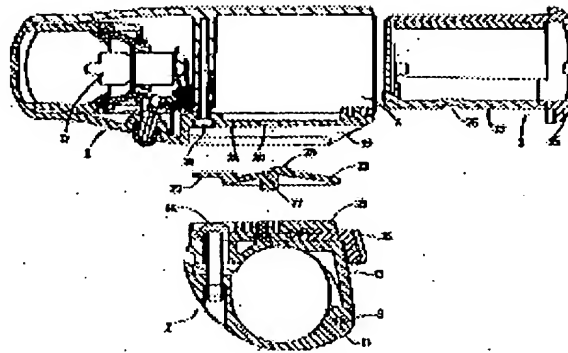
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6, 7, 8, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055).

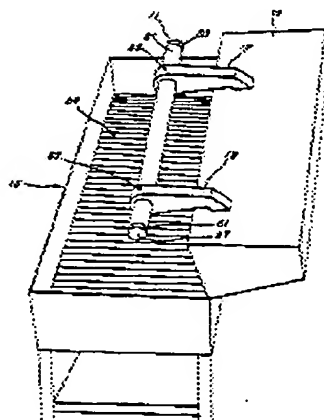
Regarding claims 1, 6, 7 and 8, Shoji disclose a fixture (1) having a first mating member (11), the fixture being fabricated to be secured to the handle (e.g., column 3, line 9), a removable first pod (1) having an illumination device (17) and a second mating member (13), the second mating member of the first pod removably engaging the first mating member of the fixture to removably secure the first pod to the fixture.

Art Unit: 2875



Shoji discloses the claimed invention, except for the housing has a first connector to specifically secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9).

Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.



Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Regarding claim 10, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member depending from the fixture is one of a male protrusion or a female receiver, and wherein the second mating member depending from the pod is the other of the male protrusion or female receiver.

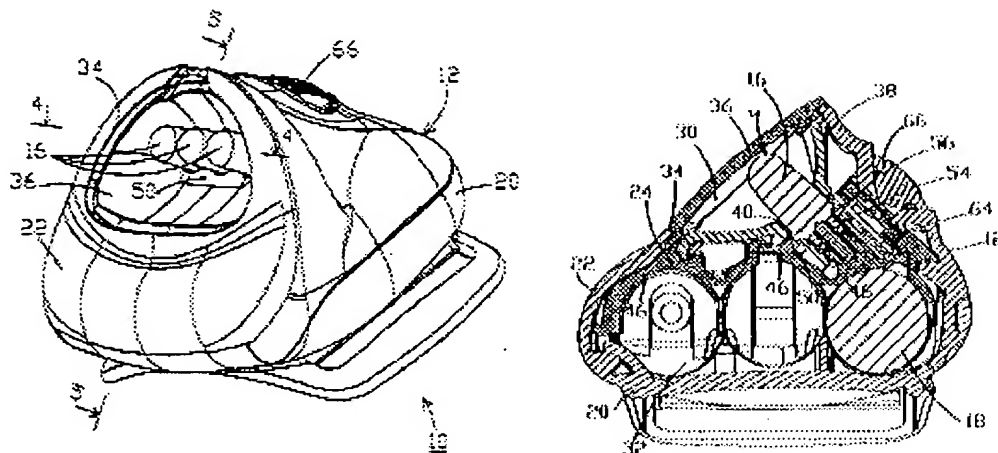
Regarding claim 11, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the male protrusion and the female receiver mate in a frictional fit to secure the pod to the fixture.

Regarding claim 12, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses one of the male protrusions and the female receiver has a stop to position the pod on the fixture.

4. Claims 2, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Petzl et al. (USPN 6,499,859).

Regarding claims 2, 9, and 13, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. Shoji lacks specific teachings of a manual switch, however drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp.

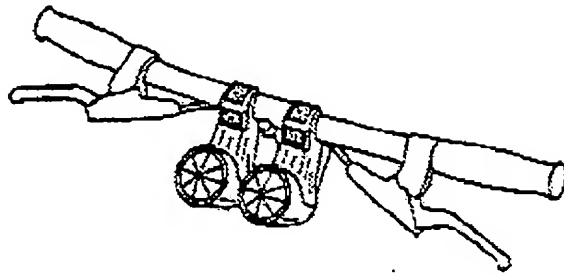


It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 3, Shoji in view of Grisamore et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11).



It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first lighting device as taught by Southerland et al. to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 4, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the first pod has a first internal power source and a first switch to independently manipulate illumination of the illumination device of the first pod, and wherein the second pod has a second internal power source and a second switch to independently manipulate illumination of the illumination device of the second pod.

Regarding claim 5, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the fixture has a handle portion (handle bar) between the first pod and the second pod.

Art Unit: 2875

6. Claims 15, 16, 17, 18, 21, 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859).

Regarding claim 15, Shoji discloses a housing (Figure 1) having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod for illuminating the illumination device of the first pod (1).

Shoji lacks specific teachings of a manual switch, however drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Regarding claim 16, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the second mating member of the first pod slidingly engages (14) the first mating member of the housing to removably connect the first pod to the housing.

Regarding claims 17 & 21, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Petzl et al. discloses the illumination device comprises a plurality of light emitting diodes (16).

Regarding claim 18, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the light bulb of the illumination device utilizes reflector and lens member to directionally focus in varying positions.

Regarding claim 22, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member removably engages the second mating member without hardware.

Regarding claim 25, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses an extension depends from the housing, and wherein the extension has a first connector to secure the extension to a surface.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) as applied to claim 15 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 19, Shoji in view of Petzl et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 20, Shoji in view of Petzl et al. and in further in view of Sutherland et al. disclose the claimed invention, explained above. In addition, Shoji discloses housing has a handle portion (column 3, line 9) for grasping by the user, the handle portion located between the first pod and the second pod when first and second pods are removably secured to the housing.

8. Claims 23, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) as applied to claim 15 above, and further in view of Grisamore et al. (USPN 6,132,055).

Regarding claims 23, 24 & 26, Shoji in view of Petzl et al. disclose the claimed invention, except for the housing has a first connector to secure the housing to a barbecue grill.

However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9).

Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been

Art Unit: 2875

obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbeque grill lid handle of Grisamore et al. to illuminate the cooking area.

9. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 27, Shoji discloses a housing (Figure 1) having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod for illuminating the illumination device of the first pod (1).

Shoji lacks specific teachings of a manual switch; however drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Shoji in view of Petzl et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, Shoji in view of Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland discloses the second mating members of the first and second pods slidingly engage the respective first mating members of the housing to independently removably connect the first and second pods to the housing.

Regarding claim 29, Shoji in view of Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Petzl et al. discloses the illumination devices of the first and second pods comprises a plurality of light emitting diodes.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) and Sutherland et al. (USPN

Art Unit: 2875

5,641,220) as applied to claim 27 above, and further in view of Grisamore et al. (USPN 6,132,055).

Regarding claim 30, Shoji in view of Petzl et al. and Sutherland et al. disclose the claimed invention, except for the housing has a first connector to secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like of a bicycle (column 3, line 9). Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.

Allowable Subject Matter

11. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 6/30/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation for example, "*a light for a barbecue grill, the barbecue grill having an upper member and a lower member defining*

Art Unit: 2875

a cooking chamber having a cooking grid, the upper member covering the lower member in a closed position” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that reference Shoji is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, reference Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, reference Shoji

Art Unit: 2875

suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9). Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.

Newly submitted claims 31-44 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: previously presented claims related to a modular light having a manual switch electrically connected to an internal power source to control illumination of the illumination device. Newly submitted claims 32-44 directed to an invention that is specifically for a barbecue grill having a light housing mounted on a lid with an automatic switch connected to the light source wherein the automatic switch is a timer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-44 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment

13. Examiner acknowledges that the applicant has amended claims 15 & 27.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



JOHN ANTHONY WARD
PRIMARY EXAM